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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/633,899

08/07/2000

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95-445

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04/23/2010

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ART UNIT

PAPER NUMBER

2451

MAIL DATE

DELIVERY MODE

04/23/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID S. GRESS, ROBERT RAYMOND SEALEY, and
THOMAS BRYANT SEALEY II

Appeal 2009-001175
Application 09/633,899
Technology Center 2400

Decided: April 23, 2010

Before JOHN A. JEFFERY, JOSEPH L. DIXON, and THU A. DANG,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-38. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and system for recording and playing a personalized voice message by a subscriber when a specific calling party reaches the subscriber's voice mail (Spec. 1).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method in an application server for playing a messaging prompt of a called party to a calling party, the method comprising:

receiving calling party number information specifying a calling party;

accessing stored calling party number information from an Internet Protocol (IP) based database server configured for storing calling party number information;

comparing the received calling party number information to the stored calling party number information to determine if there is a match between the received calling party number information and the stored calling party number information; and

based on a determined match of the stored calling party number information identifying the calling party as a matched calling party, retrieving a personalized, non generic [sic] voice message having a recorded voice of the called party corresponding to the matched, stored calling party number

information, for playback as the messaging prompt to the matched calling party.

The References

The Examiner relies on the following references as evidence:

Bobo	US 5,870,549	Feb. 9, 1999
Ng	US 6,243,376 B1	June 5, 2001 (filed Nov. 3, 1997)
Albal	US 2003/0147518 A1	Aug. 7, 2003 (filed June 30, 1999)

The Rejections

The following rejections are before us for review:

Claims 1-38 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 2, 5, 9-13, 15, 18, 19, 22, 26-29, 31, and 34-38¹ stand rejected under 35 U.S.C. § 102(e) as being anticipated by Albal.

Claims 4, 14, 20, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Albal and Ng.

Claims 3, 6-8, 16, 17, 21, 23-25, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Albal Ng, and Bobo.

¹ Although the Examiner omits claims 35-38 in the statement of the anticipation rejection, the Examiner nonetheless includes these claims in the body of the rejection. *Compare* Ans. 4 *with* Ans. 7. We therefore presume that the Examiner intended to include these claims in the anticipation rejection.

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

II. ISSUES

Has the Examiner erred in finding that claims 1-38 fail to comply with the written description requirement under 35 U.S.C. § 112, first paragraph, in particular whether the non-generic message claimed in independent claims has written description support in the Specification in such a way as to reasonably convey to a skilled artisan that the Appellants had possession the claimed invention as of the filing date?

Has the Examiner erred in finding that Albal discloses “retrieving a personalized, non generic voice message having a recorded voice of the called party corresponding to the matched, stored calling party number information, for playback as the messaging prompt to the matched calling party,” as recited in claim 1?

III. PRINCIPLES OF LAW

Written Description Requirement

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed

subject matter, rather than the presence or absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983) (citations omitted).

The term “possession,” however, has never been very enlightening. It implies that as long as one can produce records documenting a written description of a claimed invention, one can show possession. But the hallmark of written description is disclosure. Thus, “possession as shown in the disclosure” is a more complete formulation. Yet whatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

Ariad Pharmaceuticals, Inc. v Eli Lilly & Com. 598 F.3d 1336, 1351 (Fed Cir. 2010) (en banc)

Anticipation

“[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim” *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986), *overruled on other grounds by Knorr-Bremse*

Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337 (Fed.Cir. 2004).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Obviousness

“Obviousness is a question of law based on underlying findings of fact.” *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citation omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Specification

1. The Specification describes utilizing a personalized voice message for a preferred caller that reaches the called party’s voice mail and otherwise utilizing a generic voice message (Spec. 4 and 11).

Albal

2. Albal discloses that “the subscriber may instruct the communication node to play a pre-recorded message or announcement or disconnect the call.” ¶ ([0031]).

3. Albal further discloses that “[a]fter the communication node verifies the call, the node provides a greeting to the user (i.e., ‘Hi, this is your personal agent, Maya. Welcome Bob. How may I help you?’).” ¶ ([0048]).

V. ANALYSIS

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Examiner sets forth in detail a reasoned conclusion of unpatentability in the Examiner’s Answer. Therefore, we look to Appellants’ Briefs to show error in the proffered reasoned conclusion.

The Common Claimed Features

Independent claim 1, recites, *inter alia*, “retrieving a personalized, non generic [sic] voice message having a recorded voice of the called party corresponding to the matched, stored calling party number information, for playback as the messaging prompt to the matched calling party.”

Appeal 2009-001175
Application 09/633,899

Independent claims 12, 18, and 29, with different wording, contain similar limitations.

35 U.S.C. § 112 Rejection

With respect to claims 1-38, the Appellants contend that “the personalized message has been defined as non generic [sic] in the claims.” The Specification describes the personalized message and generic message in such a way as to reasonably convey that one skilled in the art possession the claimed invention as of the filing date (App. Br. 5).

We agree with the Appellants’ contention. In order to meet the “written description” requirement, an Appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but “the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *See In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (citation omitted). In other words, “the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*.” *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Here, we find that the Specification describes a personalized voice message and a generic voice message (FF 1). Clearly, the Appellants do not need to use the particular word “non-generic” to distinguish a “personalized” message from one that is generic. That is, a person of ordinary skill in the art would have recognized that the personalized voice message is tailored to a particular user and therefore would not be a generic

voice message, such as “please leave a message.” Therefore, the personalized voice message described in Appellants’ originally-filed Specification would be a non-generic message. Accordingly, we conclude that the written disclosure as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the invention, a personalized non-generic voice message. We, thus, cannot sustain the Examiner’s rejection under 35 U.S.C. § 112.

35 U.S.C. § 102(e) rejections

With respect to independent claim 1, Appellants contend that the Examiner’s § 102(e) rejection is improper because Albal does not disclose “retrieving a personalized, non generic voice message having a recorded voice of the called party.” (Reply Br. 2). According to Appellants, Albal’s pre-recorded message is not personalized to a particular calling party and the personalized greeting message is also “not a recorded voice of a called party as claimed, but a simulated voice produced by a machine.” (*Id.* at 3).

We agree with the Appellants’ contentions. We find that Albal teaches that a pre-recorded message may be played according to the subscriber’s instruction (FF 1). However, Albal does not specify the particular type of this pre-recorded message. Nor does Albal specify who makes this pre-recorded message. Furthermore, we find that it is the *communication node* that provides a greeting—not the recorded voice of a called party (FF 2). Thus, we do not find that the pre-recorded message is inherently a personalized or “non-generic” message, let alone that the

greeting generated by the communication node is a pre-recorded voice of a called party as alleged by the Examiner (Ans. 11).

Because we agree with at least one of the Appellants' contentions, we find that the Examiner has not made a requisite showing of anticipation as required for the invention as recited in claim 1 by Albal. The rejection of dependent claims 2, 5, 9-11, and 35 contains the same deficiency. Appellants, thus, have demonstrated error in the Examiner's conclusion of anticipation for the subject matter of claims 1-2, 5, 9-11, and 35.

The independent claims 12, 18, and 29 contain similar limitations to those found in independent claim 1. Appellants present similar arguments as set forth with respect to independent claim 1 in response to the rejections of independent claims 12, 18, and 29 (App. Br. 5).

As we found above in our discussion with respect to independent claim 1, we find that Appellants have demonstrated error in the Examiner's conclusion of anticipation for the subject matter of independent claims 12, 18, and 29. The rejection of dependent claims 13, 15, 19, 22, 26-28, 31, 34, and 36-38 contains the same deficiency.

We, therefore, cannot sustain the rejection of claims 1, 2, 5, 9-13, 15, 18, 19, 22, 26-29, 31, and 34-38 under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a) Rejection

With respect to claims 3, 4, 6-8, 14, 16, 17, 20, 21, 23-25, 30, and 32-33, the rejection of these claims contains the same deficiencies as the rejections of claims 1, 12, 18, and 29 under 35 U.S.C. § 102(e) discussed

above. The Examiner has not identified how the cited references Ng and Bobo remedy the noted deficiencies (Ans. 11-13). Therefore, we cannot sustain the obviousness rejection of dependent claims 3, 4, 6-8, 14, 16, 17, 20, 21, 23-25, 30, 32, and 33.

VI. CONCLUSION

We conclude that the Appellants have shown that the Examiner erred in finding that claims 1-38 fail to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

We conclude that the Appellants have shown that the Examiner erred in finding that Albal discloses “retrieving a personalized, non generic voice message having a recorded voice of the called party corresponding to the matched, stored calling party number information, for playback as the messaging prompt to the matched calling party,” as recited in claim 1.

VII. DECISION

We reverse the written description rejection of claims 1-38 under 35 U.S.C. § 112.

We also reverse the anticipation rejection of claims 1, 2, 5, 9-13, 15, 18, 19, 22, 26-29, 31, and 34-38 under 35 U.S.C. § 102(e).

We further reverse the obviousness rejection of claims 3, 4, 6-8, 14, 16, 17, 20, 21, 23-25, 30, 32, and 33 under 35 U.S.C. § 103.

REVERSED

Appeal 2009-001175
Application 09/633,899

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